No. 15-446

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

CUOZZO SPEED TECHNOLOGIES, LLC,

Petitioner,

v.

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, PATENT AND TRADEMARK OFFICE,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF OF MICROSOFT CORPORATION AND PROFESSORS VINCENT CHIAPPETTA AND LEE A. HOLLAAR AS *AMICI CURIAE* IN SUPPORT OF NEITHER PARTY

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INTEREST OF AMICI CURIAE[1]

Microsoft Corporation is a leader in the technology industry and an active and longstanding player in all aspects of the patent system. Since its founding in 1975, Microsoft has developed and marketed a wide range of software, services, and hardware products, including the flagship Windows® operating system, the Office® suite of productivity applications, the Surface tablet computer, and the Xbox® gaming system.

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1. Pursuant to Supreme Court Rule 37.6, counsel for *amici* represent that they authored this brief in its entirety and that none of the parties or their counsel, nor any other person or entity other than *amici*, or their counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Supreme Court Rule 37.3, Petitioner has filed with the Clerk of the Court a letter granting blanket consent to the filing of *amicus* briefs. Accompanying this brief is a letter from Respondent dated March 1, 2016 providing written consent to the filing of this brief.

INTRODUCTION AND SUMMARY OF ARGUMENT

Nothing is more significant to adjudication of a patent than determining the scope of its claims. This is the first step in most determinations of patent infringement and patentability. Its importance has led this Court in the last twenty years to address two jurisprudential aspects of patent claim construction: (1) whether the judge or jury construes a patent claim, and (2) the standard of appellate review of a judge's claim construction. But, what this Court has not squarely addressed, recently, is *how* to construe a patent claim. This case invites the Court to address this question.

Today, different judges apply different methodologies to patent claim construction. Under the "plain and ordinary meaning" label recited in the first Question Presented, different Federal Circuit judges apply starkly different claim-construction methodologies. Judges of the Patent Trial and Appeal Board ("PTAB") apply "broadest reasonable interpretation," also recited in the first Question Presented. Under this standard defended by the Solicitor General, the Federal Circuit has approved the PTAB's interpretation of a patent claim despite acknowledging that it was *not* the "correct construction" that would apply in court. *PPC Broadband, Inc. v. Corning Optical Comm'ns RF, LLC*, No. 2015-1361, 2016 WL 692368, *3 (Fed. Cir. Feb. 22, 2016). But, neither the PTAB nor the Federal Circuit has provided clear guidance on how "broadest reasonable interpretation" differs from either of the two (conflicting) branches of "plain and ordinary meaning" prevailing in court.

This brief describes the two conflicting branches of "plain and ordinary meaning" at the Federal Circuit, identifies three claim-construction principles this Court has approved, and argues that all judges should consistently follow those same principles, whether in court or in the PTAB.

ARGUMENT

I. THE COURT SHOULD RETIRE THE "PLAIN AND ORDINARY MEANING" BANNER IN CLAIM CONSTRUCTION.

The first Question Presented refers to the term "plain and ordinary meaning" which is the prevailing label for in-court patent claim construction. The Court should retire this label for two reasons. First, "plain and ordinary meaning" promotes inconsistency by harboring two starkly different branches in a persistent divide at the Federal Circuit over how to construe a patent claim. Second, one of these two branches exalts the acontextual meaning of patent claim language over the context found in the patent's specification and prosecution history, contrary to this Court's precedents.

A. One "Plain And Ordinary Meaning" Branch Gives Little Or No Regard To The Specification.

One branch—followed by many if not most Federal Circuit judges—reads "plain and ordinary meaning" *literally*. It elevates the acontextual dictionary meaning of the words in the claim above all else with little or no regard to the context provided by the specification, or the invention disclosed in the specification. This branch

indisputably begins on solid ground: the patent claim's undoubted role as a limitation on the scope of a patent's reach. But then it strays by treating the words of the claim as the only legitimate source of meaning in defining the claimed invention and virtually the *only* limitation on the patent's scope. In the most extreme reaches of this branch, several Federal Circuit panels have said that there is no need to even look at the specification if the language of the claim is plain on its face. For example:

> In construing a claim term, we look to the words of the claim itself. If the claim term has a plain and ordinary meaning, our inquiry ends. If, however, the claim term does not have an ordinary meaning, and its meaning is not clear from a plain reading of the claim, "we turn to the remaining intrinsic evidence, including the written description, to aid in our construction of that term."

Power Integrations, Inc. v. Fairchild Semiconductor Int'l., Inc., 711 F.3d 1348, 1361 (Fed. Cir. 2013) (citations omitted).

> the terms at issue have so clear an ordinary meaning that a skilled artisan would not be looking for clarification in the specification.

Ancora Tech., Inc. v. Apple, Inc., 744 F.3d 732, 738 (Fed. Cir. 2014).

> if there is a well-understood meaning for a term in the art, we do not allow a few inconsistent references in the specification to change

> this meaning "[because] a skilled artisan would not be looking for clarification in the specification."

Cioffi v. Google, Inc., No. 2015-1194, 2015 WL 7254039, at *10 (Fed. Cir. Nov. 17, 2015) (non-precedential).

> The district court could have ended its analysis with the plain language [of the claims].

Creative Integrated Sys., Inc. v. Nintendo of Am., Inc., 526 Fed. App'x 927, 933 (Fed. Cir. 2013) (non-precedential).

> there is no dispute that the word "secure" does not have a plain and ordinary meaning in this context, and so must be defined by reference to the specification.

VirnetX, Inc. v. Cisco Sys., Inc., 767 F.3d 1308, 1317 (Fed. Cir. 2014).

When this acontextual branch does consult the specification, it does so reluctantly, demanding a "clear and unmistakable" redefinition or disavowal of the acontextual plain meaning:

> a claim term is only given a special definition different from the term's plain and ordinary meaning if the "patentee clearly set[s] forth a definition of the disputed claim term other than its plain and ordinary meaning." A patentee can also disavow claim scope, but the standard "is similarly exacting."

Akamai Tech., Inc. v. Limelight Networks, Inc., 805 F.3d 1368, 1375 (Fed. Cir. 2015) (citation omitted).

> We depart from the plain and ordinary meaning of claim terms based on the specification in only two instances: lexicography and disavowal. The standards for finding lexicography and disavowal are exacting.

Hill-Rom Serv., Inc. v. Stryker Corp., 755 F.3d 1367, 1371 (Fed. Cir. 2014).

> This court recently reiterated the stringent standard for narrowing a claim term beyond its plain and ordinary meaning.

Aventis Pharma S.A. v. Hospira, Inc., 675 F.3d 1324, 1330 (Fed. Cir. 2012).

> To constitute disclaimer, there must be a clear and unmistakable disclaimer.

Thorner v. Sony Computer Ent. Am. LLC, 669 F.3d 1362, 1366-67 (Fed. Cir. 2012).

This acontextual approach persists despite its apparent rejection by the *en banc* Federal Circuit in 2005: "the 'ordinary meaning' of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (*en banc*). This persistence is a testament to the power of "plain and ordinary meaning"· the very label pulls judges away from a patent's context despite the *en banc* court's clear statement that the label does *not* dispense with context.

B. A Conflicting Branch Emphasizes The Context Of The Specification.

A different prominent view at the Federal Circuit resists the pull of this literal understanding of "plain and ordinary meaning." Without rejecting the "plain and ordinary meaning" banner *per se*, this second branch begins with the skilled artisan's *contextual* understanding of the claim, refusing to give the acontextual meaning a presumption of correctness. And, unlike the first branch, it interprets the claimed invention in light of the disclosed invention:

> The only meaning that matters in claim construction is the meaning in the context of the patent.

Trustees of Columbia Univ. v. Symantec Corp., No. 2015-1146, 2016 WL 386068, at *3 (Fed. Cir. Feb. 2, 2016).

> [With the trial court's broader construction] the patent would claim more than the patentee actually invented.

Sealant Sys. Int'l., Inc. v. TEK Global, S.R.L., 616 Fed. App'x 987, 993 (Fed. Cir. 2015) (non-precedential).

> Of course, "the claims cannot be of broader scope than the invention that is set forth in the specification."

Gemalto S.A. v. HTC Corp., 754 F.3d 1364, 1369 (Fed. Cir. 2014) (citation omitted).

> An inventor is entitled to claim in a patent what he has invented, but no more. He can, however, claim less, to avoid prior art or for any other reason. Therefore, in construing a claim there are two limiting factors—what was invented, and what exactly was claimed. To determine the former—what was invented—we look at the entire patent, with particular attention to the specification (the written description of the invention and the several claims made). To determine the latter—what exactly was claimed—the focus is on the precise words of the particular claim or claims at issue; the written description and preferred embodiments are aids in understanding those words. In the case before us, proper claim construction requires that we understand what the invention encompasses as well as how the claims are stated.

MySpace, Inc. v. Graphon Corp., 672 F.3d 1250, 1256 (Fed. Cir. 2012).

> In reviewing the intrinsic record to construe the claims, we strive to capture the scope of the actual invention, rather than strictly limit the scope of claims to disclosed embodiments or allow the claim language to become divorced from what the specification conveys is the invention.

Retractable Tech's., Inc. v. Becton, Dickinson and Co., 653 F.3d 1296, 1305 (Fed. Cir. 2011).

The first, acontextual, branch rejects this second, contextual approach:

> It is not for the court to tailor the claim language to the invention disclosed.

Retractable Tech's., Inc. v. Becton, Dickinson and Co., 659 F.3d 1369, 1371 (Fed. Cir. 2011) (Moore, J. (joined by Rader, J.) dissenting from denial of rehearing *en banc*).

C. These Conflicting "Plain And Ordinary Meaning" Approaches Cause Inconsistency.

Unsurprisingly, these starkly contrary approaches have contributed to a notorious lack of uniformity and predictability in patent claim constructions, and wasteful claim-construction disputes. *See e.g.*, Tun-Jen Chiang & Lawrence B. Solum, *The Interpretation-Construction Distinction in Patent Law*, 123 YALE L.J. 530, 534 (2013) ("The uncertainty in how courts will apply claims most typically arises because judges have core policy disagreements about the underlying goals of claim construction."); Christian E. Mammen, *Patent Claim Construction as a Form of Legal Interpretation*, 12 J. MARSHALL REV. INTELL. PROP. L. 40, 49 (2012) ("Claim construction rulings are seen as relatively volatile, unpredictable, and subject to second-guessing on appeal."); R. Polk Wagner & Lee Petherbridge, *Did Phillips Change Anything? Empirical Analysis of the Federal Circuit's Claim Construction Jurisprudence*, in INTELLECTUAL PROPERTY AND THE COMMON LAW 123, 128 (Shyamkrishna Balganesh ed., 2012) (concluding that the Federal Circuit has failed to resolve its longstanding divide on claim construction, resulting

in significant variability, uncertainty, and lack of predictability).

D. Disregarding Claim Amendments, Unless They Are Unambiguous, Promotes Gamesmanship.

As noted, the acontextual "plain and ordinary meaning" branch demands a "clear and unmistakable" disclaimer before abandoning the acontextual plain meaning of claim language. This rule is applied to the prosecution history as well as to the specification. In particular, a patent applicant's actions and statements in the Patent Office to overcome the prior art are essentially disregarded, unless they constitute an *unambiguous* disclaimer:

> When the prosecution history is used solely to support a conclusion of patentee disclaimer, the standard for justifying the conclusion is a high one. "[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable." Where the alleged disavowal is ambiguous, or even "amenable to multiple reasonable interpretations," we have declined to find prosecution disclaimer.

Avid Tech., Inc. v. Harmonic, Inc., No. 2015-1246, 2016 WL 363410, at *4 (Fed. Cir. Jan. 29, 2016) (citation omitted).

This "high" standard for allowing a patent claim's prosecution history to restrict the acontextual "plain and ordinary meaning" of the claim language, invites

gamesmanship. It invites patent drafters to *imply* to Patent Office examiners a narrow scope of claim coverage—to avoid the prior art—while avoiding an *unambiguous* disclaimer of the acontextual "plain and ordinary meaning" which the patent owner might later wish to assert for infringement purposes. In effect, "plain and ordinary meaning" invites patent applicants to avoid clarifying claim meaning and to inject ambiguity into the patent's intrinsic record.

And patent owners are not alone in such strategic behavior. Patent challengers likewise seek advantage from the current state of patent claim-construction law. Often they assert a broad interpretation of the patent claim when challenging it for unpatentability in the Patent Office while preserving the right to argue for a narrower interpretation of the same claim to avoid infringement in court.

In sum, the "plain and ordinary meaning" label that Petitioner urges be extended to the PTAB describes two contradictory methodologies—merely papering over a persistent and unresolved disagreement that divides the Federal Circuit—and fails to provide clarity or useful guidance to trial courts. Worse yet, the overly-literal understanding of the phrase advocated by some has led to overbroad, inconsistent constructions, and frequent gamesmanship. In this respect, the "plain and ordinary meaning" label is reminiscent of the "insolubly ambiguous" label retired in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014). In each case, the label *per se* did not uniformly foreclose a correct application of the law, but the very words beg for and too often lead to an incorrect application. *Id.* at 2130. The Court therefore should retire

this label and provide the uniform claim-construction guidance that judges need.

II. A CLAIM'S SCOPE IS LIMITED BY THE CONTEXTUAL MEANING OF ITS WORDS, THE PATENT'S INVENTION, AND THE CLAIM'S AMENDMENTS.

In place of "plain and ordinary meaning," the Court should endorse the claim-construction principles found in its precedents. First, the scope of a patent claim is limited by the claim language as understood by a skilled artisan at the time of the alleged invention and in the context of the specification and prosecution history. Second, it is limited, presumptively, by the scope of the patent's disclosed invention. Third, narrowing amendments of a patent claim in the Patent Office are strictly construed against the patent owner.

A. The Claim Language Must Be Read In Context.

"A word is not a crystal, transparent and unchanged, it is the skin of a living thought and may vary greatly in color and content according to the circumstances and the time in which it is used." *Towne v. Eisner*, 245 U.S. 418, 425 (1918). This recognition guides interpretation of a contract: a "cardinal principle of contract construction" is "that a document should be read to give effect to all its provisions and to render them consistent with each other." *Mastrobuono v. Shearson Lehman Hutton, Inc.*, 514 U.S. 52, 63-64 (1995) (citations omitted). And a statute: "the meaning—or ambiguity—of certain words or phrases may only become evident when placed in context It is a 'fundamental canon of statutory construction that the

words of a statute must be read in their context and with a view to their place in the overall statutory scheme.'" *Nat'l Ass'n of Home Builders v. Defenders of Wildlife*, 551 U.S. 644, 666 (2007) (citation omitted).

This same principle of contextual interpretation naturally applies to patent claims. A court must apply to patent claims "the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389-90 (1996). And, courts must seek that construction which "fully comports with the specification and claims and so will preserve the patent's internal coherence." *Id.* This internal coherence is determined from the perspective of the skilled artisan, sometimes provided by the testimony of experts in the field or other secondary evidence extrinsic to the patent. *Id.* at 387-88.

A patent claim's context also includes its prosecution history in the Patent Office. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 33 (1966) ("an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office.")

B. The Claim's Scope Presumptively Is Limited To The Invention Disclosed In The Patent.

The second fundamental claim-construction principle is not one of general applicability. It derives instead from a core public policy of our patent system, as reflected in the Patent Act, the Constitution, and this Court's precedents.

The Patent Act mandates that an applicant claim only that which the inventor regards as the invention and discloses in the specification: "the specification shall contain a written description of the invention," 35 U.S.C. § 112(a), and "the specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention," *id.* § 112(b). Coupling this statutory mandate with the statutory presumption of validity, *id.* § 282(a), requires a correspondence between the invention disclosed in the specification and the scope of the claims. "In reviewing the intrinsic record to construe the claims, we strive to capture the scope of the actual invention, rather than strictly limit the scope of claims to disclosed embodiments or allow the claim language to become divorced from what the specification conveys is the invention." *Retractable Tech's.*, 653 F.3d at 1305.

The Patent Office directs its Examiners to require correspondence of the claimed invention to the disclosed invention: "The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 C.F.R. § 1.75(d)(1). This does not mean, of course, that every issued claim actually complies with this or any other patentability condition, but they do so presumptively and that presumption should guide a judge's interpretation of the claim.

This interpretation of the Patent Act—presumptively limiting the claimed invention to the disclosed invention—

is further bolstered by the Constitution's limitation on the Congressional authority to grant patents. The Constitution gives Congress a *limited* authority: "To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." U.S. Const., Art. I, § 8, cl. 8. The Court has read this as "both a grant of power and a limitation" having "restraints imposed by the stated constitutional purpose." *Graham*, 383 U.S. at 5-6. In particular, Congress may not authorize the grant of patents that exceed the inventor's invention:

> The grant to the inventor of the special privilege of a patent monopoly carries out a public policy adopted by the Constitution and laws of the United States, "to promote the Progress of Science and useful Arts, by securing for limited Times to Inventors the exclusive Right " to their "new and useful" inventions. But the public policy which includes inventions within the granted monopoly excludes from it all that is not embraced in the invention.

Morton Salt Co. v. GS Suppiger Co., 314 U.S. 488, 492 (1942) (citations omitted).

This same claim-interpretation principle is followed abroad as well. The European Patent Office limits a claimed invention to the disclosed invention, treating patent claim construction as more than a merely linguistic exercise: "The interpretation of the terms of a claim must be made by the skilled person, not by a philologist. Terms in the claims must therefore be construed as they would be by the skilled person in view of the overall content of the

specification, according to the idea behind the invention, having regard to the problem and solution as derived from the patent." Case No. T 1857/08 (European Patent Office Board of Appeals May 17, 2011) (citations omitted).

C. Claim Amendments Are Strictly Construed Against The Patent Owner.

The third fundamental claim-construction principle concerns the patent's prosecution history.

A Patent Office examiner often rejects initially proposed claims as being too close to the prior art, which generally results in adoption of narrowing amendments that limit the scope of the claims to patentable subject matter, and lead to issuance of the patent. Later, however, a patent owner enforcing the patent may be tempted to downplay the significance of the narrowing amendments and assert the broader scope of protection that was sought in the initial, abandoned claims. This Court has taken a firm stance against such attempts.

A claim amendment during prosecution of a patent "operates as a disclaimer" and "must be strictly construed against [the applicant]" and in favor of the public. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942). By substituting one phrase for another to overcome a rejection of a proposed patent claim, the patent applicant "recognize[s] and emphasize[s] the difference between the two phrases and proclaim[s] his abandonment of all that is embraced in that difference." *Id.* at 136-37.

In *Hubbell v. United States*, 179 U.S. 77 (1900), the Court affirmed a narrow claim construction and judgment

of no infringement primarily on account of the prosecution history in which the original application's claims were repeatedly narrowed to overcome rejections by the Patent Office. "'Limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers.'" *Id.* at 83-84 (citation omitted).

III. THESE PRINCIPLES APPLY WHEREVER AN ISSUED PATENT CLAIM IS INTERPRETED.

PTAB judges and district court judges should apply these same claim-construction principles to issued patent claims. (*Amici* take no position on whether the PTAB has or has not followed these principles when construing issued patent claims under the "broadest reasonable interpretation" banner.)

A. The Patent Statute Requires That Claims Be Construed Consistently.

An issued patent claim must be consistently interpreted. This seemingly indisputable proposition rests on several provisions of the Patent Act.

First, a patent "shall have the attributes of personal property," 35 U.S.C. § 261, and one defining attribute of an item of personal property is a fixed boundary distinguishing it from other items of personal property. This is as true of a patent claim when it is interpreted by a PTAB judge as when it is interpreted by a district court judge. The extent of an item of personal property

does not vary depending on which tribunal is adjudicating that property.

Second, a fixed boundary also is a prerequisite to the patent claim's public notice function embedded in the statute's clarity and precision demand, 35 U.S.C. § 112(b). This too is as true of a patent claim when it is interpreted by a PTAB judge as when it is interpreted by a district court judge.

Third, that an issued patent claim must be consistently interpreted follows from the statutory language of the America Invents Act ("AIA") creating PTAB trial proceedings.

The AIA created inter partes review (IPR) proceedings for Patent Office judges to determine the "patentability of any patent claim challenged by the petitioner." 35 U.S.C. § 318(a). But it limited the patentability challenges to sections 102 (anticipation) and 103 (obviousness) of the Patent Act. *Id.* § 311(b). Sections 102 and 103 define conditions for patentability of a "claimed invention." "Claimed invention" is defined as "the subject matter defined by a claim in a patent . " *Id.* § 100(j). The Patent Act does not expressly address how to ascertain the scope of the claimed invention, with one limited exception. That exception specifies how to construe a particular type of functional element in a patent claim. *See* 35 U.S.C. § 112(f) ("such claim shall be construed to ").

These statutory provisions define universally-applicable requirements for patentability and claim interpretation that apply uniformly to court and PTAB adjudications. The sole express claim-construction

provision, 35 U.S.C. § 112(f), makes no exception for PTAB trials. Nor do sections 102 and 103, which define "patentability" conditions. Nothing in the AIA or Patent Act authorizes the PTAB to determine the patentability of something other than "the claimed invention." Instead, sections 102 and 103 provide the same single standard governing these patentability determinations in the PTAB as in court, and they require that the claimed invention, *properly construed*, be compared to the prior art. They do not countenance a "what if" exercise: would the claim be unpatentable if it were broader than it is? *See In re Cuozzo Speed Tech., LLC*, 793 F.3d 1268, 1286 (Fed. Cir. 2015) (Newman, J., dissenting) ("These legal rights must be the 'correct' rights, not some fuzzy 'broadest' measure.")

B. Markman Supports Consistent Constructions Of A Patent Claim.

This straightforward interpretation of the statute—that it demands the same claim constructions in the PTAB as in court—is reinforced by *Markman*. That a patent claim's scope must be consistently interpreted was one lesson of *Markman*, 517 U.S. at 373, and a primary reason why claim construction is entrusted to judges, not juries. The Federal Circuit in *Markman* recognized the importance of recognizing a single "true and consistent scope" of a patent claim, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996), as did this Court: "we see the importance of uniformity in the treatment of a given patent as an independent reason to allocate all issues of construction to the court." *Markman*, 517 U.S. at 390. It would be strange indeed to entrust claim construction to one set of judges (Article III judges) with the goal of

achieving more clarity and uniformity than juries, but then allow hundreds of other judges (those in the Patent Office) to adjudicate patentability based on a *different* interpretive methodology.

C. Neither The Presumption Of Validity Nor The Option To Amend Justifies Inconsistent Constructions Of A Patent Claim.

The Government argues that the presumption of validity, 35 U.S.C. § 282(a) ("A patent shall be presumed valid. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity"), applies in court but not in the PTAB. But the AIA expressly places the burden of proving unpatentability under sections 102 or 103 on the challenger: "the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence." *Id.* § 316(e). And, for other unpatentability grounds, the AIA does not permit any challenge at all in an IPR proceeding.

The Government argues that the PTAB's power to authorize amendments to patent claims justifies it giving an issued patent claim a different scope than it has in court. But, a patent owner enforcing its patent in court also has an avenue for amending an issued patent claim. The patent owner can return to the Patent Office to amend its patent claims, via a certificate of correction, 35 U.S.C. §§ 254-255, or in a reissue proceeding, *id.* § 251. These long-available avenues for amending claims do not justify a court giving the issued patent claim an incorrect construction.

D. This Case Does Not Address Unissued Patent Claims.

Unissued patent claims present a different question. They do not define the "metes and bounds" of the owner's property right. Judge Newman, in her dissenting opinion, explained why unissued claims may be treated differently: "The question is not whether a 'broadest' construction protocol has a place in the examination of pending applications, where proposed claims are readily amended in the give-and-take of patent prosecution. However, after the patent has issued, announcing a property right on which the patentee and the public rely, the claims must be construed correctly." *In re Cuozzo Speed Tech., LLC*, 793 F.3d 1268, 1286 (Fed. Cir. 2015) (Newman, J., dissenting).

CONCLUSION

The Court should require that issued patent claims be interpreted in the same manner in court and in the PTAB, guided by the claim-construction principles the Court has approved, not "plain and ordinary meaning."

Respectfully submitted,

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